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09/893,240	06/26/2001	Jessica M. Barnes	10420/17	4905

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EXAMINER

DIXON, THOMAS A

ART UNIT PAPER NUMBER

3639

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/893,240

Applicant(s)

BARNES ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The interview of 10/5/05 and the amendment of 10/6/05 have been considered.
2. Applicant's arguments that Marjo does not disclose all the features of the independent claims is mistaken, the reference as a whole teaches the concept of sending information regarding passengers from the origin nation to the destination nation and bypassing further processing based on the data was anticipated by Marjo.

As per Claim 1, the system in various forms was implemented in Singapore, Tel Aviv, the United States and Vancouver, see lines 7-24. The entry of the data the second time before departure and verifying identity is seen in line 6, the breezing through to the boarding gate and the camera automatically being used to enter the data (face), verify the identity of the person, and check the manifest to see that the person is a passenger on that plane. Line 11, then refers to the destination, where the passenger again breezes through checkpoints.

The "procedure" added is not supported by the specification.

As per Claims 3 and 4, the scan of the person's image is seen to be recording at the destination country as the image is recorded, and the recording on the plane, are not disclosed.

As per Claims 15-22.

Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). Further, there is no communication between the two country's computers as claimed in claims 1 and 23.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

The structural limitations of claim 15, including computer interfaces, computer memories and recognition software are disclosed in Marjo as described herein.

Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The amendment filed 10/06/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "a procedure" added to claim 1 is not supported by the specification as filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase "in accordance with the data and a procedure from the government or governmental agent" is confusing, as the "procedure" is not supported by the specification. Further Claims 11, 13 and 14 reference "the procedure" that is not supported by the specification.

5. Claims 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is unclear how the data entered, the computers, and memories are related because the data appears to be entered at both countries and there is no communication between the countries' computers as in claims 1 and 23.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, tangible and concrete result. An invention which is eligible for patenting under 35 U.S.C 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a useful, concrete and tangible result. The fundamental test for patent eligibility is thus to determine whether the claimed invention

produces a useful tangible and concrete result. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ 2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors.

a) “useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will not that::

i. utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

b) “tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 UAPQ 2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than manipulation of an abstract idea and is, therefore, nonstatutory under 35 U.S.C 101. In *Warmerdam*, the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

c) “concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, The claimed invention is not seen to be concrete as the “instruction” is from the government official, and appears to be a subjective evaluation, rather than a repeatable outcome.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-2, 5-9, 12-13, 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Marjo “Picking up the Pace. (Biometric technology in air travel)”

As per Claim 1.

Marjo discloses:

entering information identifying the passenger a first time into a computer interface, page 1, lines 5-6;

recording a first electronic image of the passenger, see page 1, lines 8-10;

comparing a prior image of the passenger to the first image, see page 1, line 18;

sending information identifying the passenger to a government or government agent in a destination country, see page 47-54;

entering information identifying the passenger a second time into a computer interface before departure and verifying an identity of the passenger, see page 1, lines 3-10;

recording a second electronic image of the passenger, see page 1, lines 11-19;

comparing the second image to a prior image of the passenger, see page 1, lines 16-19; and

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routing the passenger in accordance with the data and an instruction from the government or government agent, see page 1, lines 12 and 47-54.

As per Claim 2.

Marjo further discloses the first electronic image is recorded in an originating country, see page 1, lines 8-10.

As per Claim 5.

Marjo further discloses the electronic image is selected from a group consisting of a photograph, a fingerprint an iris scan and a voiceprint, see page 2, lines 33-34.

As per Claim 6.

Marjo further discloses the entering of flight information for the passenger into the computer interface, see page 1, lines 5-6.

As per Claim 7.

Marjo further discloses retrieving data of passengers scheduled for a flight from a first computer memory and storing the data in a second computer memory, see page 1, lines 8-10 and 33-35.

As per Claim 8.

Marjo further discloses the comparing is performed by a computer with software selected from the groups consisting of feature recognition software, voice recognition software and facial recognition software, see page 1, lines 17-18.

As per Claim 9.

Marjo further discloses taking a subsequent image of the passenger and comparing the subsequent image to the first electronic image, and routing the passenger according to the result of a comparison of the first electronic image and the subsequent image, see page 1, lines 11-12, 17-23.

As per Claim 12.

Marjo further discloses giving the passenger notice of an instruction of the government or government agent, see page 1, lines 48-49.

As per Claim 13.

Marjo further discloses no instruction is received from the government and the passenger is not required to process through customs, see page 1, lines 11-12.

As per Claims 15-22.

Marjo discloses:

a computer interface, see page 1, lines 5-6, and line 13 and memory, see page 1, lines 17-18;

a camera linked to a computer, see page 1, lines 8-10;



feature, voice or facial recognition software, see page 1, lines 17-18.

Also as described the limitations of the claim and its dependents do not distinguish the claimed apparatus from the prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marjo "Picking up the Pace. (Biometric technology in air travel)" in view of Official Notice.

As per Claim 10.

Marjo discloses filling out forms on a computer and sending them to an agent of the government and routing the passenger according to a government or government agent, see page 1, lines 5-6 and lines 15--23, but does not specifically disclose filling out customs declaration forms.

Official Notice is taken that it is old and well known that any type of form can be filled out and sent, therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to fill out a customs declaration form in Marjo's system for the benefit of increased speed of processing through the airport.

9. Claims 11 is rejected under 35 U.S.C. 102(a) as being anticipated by Marjo "Picking up the Pace. (Biometric technology in air travel)" in view of Diamond et al (6,698,653).

As per Claim 11.

Marjo further discloses a tag with memory associated with the baggage, sending the data (tag with baggage) and routing the baggage, see page 2, lines 17-19, but does not disclose electronically inspecting luggage of the passenger, making a record of the electronic inspecting, entering the record into the computer memory, sending to the government or government agent, and routing the baggage in accordance with the government or government agent.

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Diamond et al (653) teaches inspecting luggage of the passenger, making a record of the electronic inspecting, entering the record into the computer memory, sending to the government or government agent, and routing the baggage in accordance with the government or government agent, see figure 2 (22, 23), figure 6 (78, 79, 84) and figure 9 (134) for the benefit of monitoring that baggage contains no prohibited items and that passengers board the plane with their luggage.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to inspect baggage, enter records into a computer memory and send the data to an agent and route the baggage in accordance with the agent for the benefit of monitoring that baggage contains no prohibited items and that passengers board the plane with their baggage..

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marjo

"Picking up the Pace. (Biometric technology in air travel)" in view of applicant's disclosure.

As per Claim 14.

Marjo does not specifically disclose if no instruction is received from the government or government agent and the passenger is automatically required to process through customs or immigration or both customs and immigration.

Applicant's application, page 1, lines 19-21 teaches that it is old and well known to automatically require the passenger to process through customs and immigration to control the flow of goods and people into a country.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to if no instruction is received from the government or government agent and the passenger is automatically required to process through customs or immigration or both customs and immigration to control the flow of goods and people into a country.

11. Claims 23-24 are rejected under 35 U.S.C. 102(a) as being anticipated by

Pugliese, III (6,044,353) in view of Sweatte (6,335,688).

As per Claim 23.

Pugliese, III ('353) discloses a passenger, baggage, and baggage of the passenger, and information concerning the passenger and baggage, see abstract; gathering information and sending information concerning the passenger and baggage of the passenger, wherein the information concerning the passenger and the baggage of the passenger is automatically gathered and processed, see column 4, lines 16-35;

sending the baggage through an electronic baggage inspection, sending the baggage to the second country, and routing the baggage to a location selected from the

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group consisting of customs, a baggage claim area, and a connecting flight of a passenger, see column 4, lines 36-52;

sending the passenger from an origin to a destination, and sending the passenger to further processing selected from the group consisting of customs, immigration and no further processing, see column 4, line 65 – column 5, line 19.

Pugliese III ('353) does not specifically disclose sending the passenger from a first country to the second country, information sent to a government official of a second country and sending a passenger to further processing depending on the interest of a government official of the second country.

Sweatte ('688) teaches notification of immigration or customs, see abstract, for the benefit of letting airline and security personnel know when an unexpected or unwanted event or person is in the system to allow them to determine if they are interested in the passenger.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to notify immigration or customs, as taught by Sweatte, for the benefit of letting airline and security personnel know when an unexpected or unwanted event or person is in the system.

As per Claim 24.

Pugliese, III ('353) further discloses scheduling travel of a passenger and transferring data concerning the passenger from a first computer memory to a second computer memory, see column 5, line 61 – column 6, line 14.

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pugliese III (6,044,353) in view of Sweatte (6,335,688) further in view of Official Notice.

As per Claim 25.

Pugliese III ('353) discloses filling out forms on a computer, see column 3, line 62 – column 4, but does not specifically disclose filling out customs declaration forms.

Official Notice is taken that it is old and well known that any type of form can be filled out and sent, therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to fill out a customs declaration form in Pugliese III's system for the benefit of increased speed of processing through the airport.

13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pugliese III (6,044,353) in view of Sweatte (6,335,688) further in view of applicant's disclosure.

As per Claim 26.

Pugliese, III ('353) does not disclose the passenger proceeds to an immigration booth upon arrival in the second country to automatically verify his or her identification and to receive instructions for proceeding.

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Sweatte ('688) teaches automatic verification of identification of persons arriving in a second country and notification of immigration or customs, see abstract, for the benefit of letting airline and security personnel know when an unexpected or unwanted event or person is in the system to allow them to determine if they are interested in the passenger.

Applicant's application, page 1, lines 19-21 teaches that it is old and well known to automatically require the passenger to process through customs and immigration to control the flow of goods and people into a country.

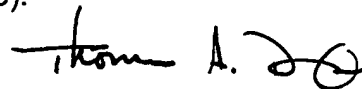
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to if no instruction is received from the government or government agent and the passenger is automatically required to process through customs or immigration or both customs and immigration to control the flow of goods and people into a country.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3639

December 05